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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,584	04/05/2001	Gerhard Albrecht	512425-2059	5913
20999	7590	04/22/2004		
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER EGWIM, KELECHI CHIDI	
			ART UNIT	PAPER NUMBER

1713

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/827,584	Applicant(s) ALBRECHT ET AL.	
	Examiner Dr. Kelechi C. Egwim	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-34 is/are pending in the application.
- 4a) Of the above claim(s) 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-32 and 34 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☒ Claim(s) 25-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:
2.
 - a) wherein the coating material is a one-component coating material. (Claim 32)
 - b) wherein the coating material is a two-component coating material. (Claim 33)

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 31 is generic to the species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

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showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. During a telephone conversation with Mark W. Russell on 4/16/04, a provisional election was made with traverse to prosecute the invention of species a), claims 25-32 and 34. Affirmation of this election must be made by applicant in replying to this Office action. Claim 33 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Due to amendments by applicant, the previous 112 rejections of record have been overcome and are hereby withdrawn.

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Claim Objections

6. Claim 26 is objected to because of the following informalities: The claim repeats the term "a glycol ester" at the end of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. At the bottom of page 21, claim 34 recites the limitation "wherein the polymerization occurs in aqueous solution at a temperature of from about 20 to about 100°C in the presence of a free-radical initiator". However, there is insufficient antecedent basis for this limitation in the claim since there is no polymerization process previously defined anywhere in the claim.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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11. Claims 25-28 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Fuse et al. (JP 01250497) or Suzuki et al. (JP 62079204).

In each of the abstract, Fuse et al. or Suzuki et al. teach pigment concentrates comprising a pigment, such as an inorganic pigment, in an aqueous dispersion with the claimed copolymers.

Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

12. Claims 25-28, 31 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsubakimoto et al. (US 4,471,100) or Okumura (JP 04013783).

In col. 1, line 47 to col. 2, line 44 and col. 6, lines 4-7 of Tsubakimoto et al. and in the abstract of Okumura, the prior art teaches pigment concentrates comprising inorganic pigments in an aqueous dispersion with the claimed copolymers, which may be applied as ink or paper coatings.

Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

13. Claims 25-29, 31 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirasa (US 5,859,092)

In col. 1, line 41 to col. 2, line 23, the examples in col. 3-7 and col. 8, lines 30-57, Hirasa teaches a recording liquid comprising inorganic pigments, such as zinc oxide, in an aqueous dispersion with the claimed copolymers, wherein the composition may further comprising water-soluble resins. In this case, monomer unit A in Hirasa reads on both monomer a) and monomer c) in the present claims.

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Thus, the requirements for rejection under 35 U.S.C. 102(b) are met.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuse et al., Suzuki et al., Tsubakimoto et al. or Okumura.

While Fuse et al., Suzuki et al., Tsubakimoto et al. or Okumura, above, do not recite transparent iron oxide as the inorganic pigment in their pigment formulations, the species of genus is prima facie obvious. It is applicants burden under these to establish that species of inorganic pigment provides some unexpected results over the inorganic pigments of the applied reference(s). See *In re Woodroff*, 16 USPQ2d 1934(Fed. Cir. 1990); *In re Susi* 169 USPQ 423 (CCPA 1971).

16. Claims 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirasa.

While Hirasa does not recite transparent iron oxide as the iron oxide in the pigment formulation, the species of genus is prima facie obvious. It is applicants burden under these to establish that species of iron oxide provides some unexpected results

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over the iron oxide pigments of the applied reference(s). See *In re Woodroff*, 16

USPQ2d 1934(Fed. Cir. 1990); *In re Susi* 169 USPQ 423 (CCPA 1971).

Further, regarding the particular water-soluble resin in the pigment containing in the formulation of Hirasas, although Hirasas does not disclose any particular resin, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to use any water-soluble resin, including the water-soluble resins of claim 32, as the resin in Hirasas. Furthermore, the applicant has failed to point out the criticality of these particular resins in the novelty of the present invention. The applicant has not shown unexpected results from using these resins as resin materials.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (703) 306-5701. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KCE


KELECHI C. EGWIM PH.D.
PRIMARY EXAMINER